

### REMARKS

This is a full and timely response to the non-final Office Action mailed by the U.S. Patent and Trademark Office on December 4, 2008. Claims 14-17 and 19-21 remain pending in the present application. Claims 8-13 and 22-31 are withdrawn from consideration as being drawn to a non-elected invention, and are canceled herein without prejudice, waiver or disclaimer. Claims 1-7 are canceled without prejudice waiver or disclaimer. Applicants reserve the right to prosecute claims 1-13 and 22-31 in a continuing application. Claim 14 is amended with the subject matter of allowable claim 18. Claim 18 is canceled. The specification is amended to correct a typographical error. No new matter is introduced.

In view of the foregoing amendments and following remarks, reconsideration and allowance of the present application and pending claims are respectfully requested.

#### Allowable Subject Matter

The Office Action, on page 3, indicates that claim 18 would be allowable if rewritten in independent form to include the subject matter of claim 14. However, the Office Action Summary sheet indicates that claim 17 is objected to. Applicants will proceed under the assumption that claim 18 is objected to. Applicants hereby request clarification in a subsequent non-final action if Applicants have misinterpreted the intent of the Office Action.

Applicants have amended claim 14 with the subject matter of allowable claim 18. Accordingly, Applicants respectfully submit that claim 14 is allowable. Applicants also respectfully submit that claims 15-17 and 19-21 are allowable for at least the reason that they depend directly from allowable claim 14.

#### Rejection Under 35 U.S.C. § 102

Claims 1, 3 and 5-6 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 6,720,583 to Nunoue *et al.* (hereafter *Nunoue*). A proper rejection of a claim under 35 U.S.C. § 102 requires that a single prior art reference disclose each element of the claim. *See, e.g., W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983). Anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. *See, e.g., In re Paulsen*, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994); *In re Spada*, 911 F.2d 705,

15 USPQ2d 1655 (Fed. Cir. 1990). Alternatively, anticipation requires that each and every element of the claimed invention be embodied in a single prior art device or practice. *See, e.g., Minnesota Min. & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992). The test is the same for a process. Anticipation requires identity of the claimed process and a process of the prior art. The claimed process, including each step thereof, must have been described or embodied, either expressly or inherently, in a single reference. *See, e.g., Glaverbel S.A. v. Northlake Mkt'g & Supp., Inc.*, 45 F.3d 1550, 33 USPQ2d 1496 (Fed. Cir. 1995). Those elements must either be inherent or disclosed expressly. *See, e.g., Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 7 USPQ2d 1057 (Fed. Cir. 1988); *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987). Those elements must also be arranged as in the claim. *See, e.g., Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989); *Carella v. Starlight Archery & Pro Line Co.*, 804 F.2d 135, 231 USPQ 644 (Fed. Cir. 1986). For anticipation, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *See, e.g., Scripps Clinic & Res. Found. v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ2d 1001 (Fed. Cir. 1991).

Accordingly, the single prior art reference must properly disclose, teach or suggest each element of the claimed invention.

Claims 1, 3 and 5-6 are canceled. Accordingly, the rejection of claims 1, 3 and 5-6 is moot.

### **Rejections Under 35 U.S.C. § 103**

#### **Claims 2, 4 and 7**

Claims 2, 4 and 7 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Nunoue* in view of Streubel *et al.* at other publications section on page 1 of U.S. Patent No. 6,720,583 (*Nunoue*) (hereafter *Streubel*). For a claim to be properly rejected under 35 U.S.C. § 103, “[t]he PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” *In re*

*Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988) (Citations omitted). Further, for a proper rejection under 35 U.S.C. § 103(a), a combination of references must expressly or impliedly suggest all of the features of the claimed invention, *i.e.*, all of the features cited in the claims at issue. *In re Gorman*, 933 F.2d 982, 18 USPQ 1885 (Fed. Cir. 1991). Hindsight reconstruction is impermissible. *See, e.g., Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 19 USPQ2d 1111 (Fed. Cir. 1991). Further, “[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” *In re Fritch*, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780 (Fed Cir. 1992).

Applicants have canceled claims 2, 4 and 7, and submit that the rejection is moot.

#### Claims 14, 17, 19 and 21

Claims 14, 17, 19 and 21 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Nunoue* in view of U.S. Patent application Publication No. 2002/0131464 to Sirbu *et al.* (hereafter *Sirbu*).

Applicant has amended claim 14 with the subject matter of allowable claim 18. Accordingly applicants respectfully submit that claim 14 is allowable. Applicants further submit that claims 17, 19 and 21 are allowable for at least the reason that they depend directly from allowable claim 14. *In re Fine*, 837 F.2d 1071, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1998).

#### Claims 15, 16 and 20

Claims 15, 16 and 20 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Nunoue* in view of *Sirbu* and further in view of *Streubel*.

Applicant has amended claim 14 with the subject matter of allowable claim 18. Accordingly applicants respectfully submit that claim 14 is allowable. Applicants further submit that claims 15, 16 and 20 are allowable for at least the reason that they depend directly from allowable claim 14. *In re Fine*, *supra*.

### **CONCLUSION**

For at least the foregoing reasons, Applicants respectfully request that all outstanding rejections be withdrawn and that all pending claims of this application be allowed to issue. If the Examiner has any comments regarding Applicants' response or intends to dispose of this matter in a manner other than a notice of allowance, Applicants request that the Examiner telephone Applicants' undersigned attorney.

Respectfully submitted,

**SMITH FROHWEIN TEMPEL**  
**GREENLEE BLAHA LLC**  
**Customer No. 35856**

By: /Michael J. Tempel/  
Michael J. Tempel  
Registration No. 41,344  
(770) 709-0056